



to B2
JTI

PATENT

TO THE BOARD OF PATENT APPEALS AND INTERFERENCES OF THE UNITED
STATES PATENT AND TRADEMARK OFFICE
CASE NO. 97,610

In re Application of:)
BISKER) Group Art Unit: 1513
Serial No.: 08/372,509) Examiner: A. Bahta
Filed: January 13, 1995)
For: DECORATIVE PHOTOGRAPHIC)
AND METHOD OF USING)
SAME)

BRIEF ON APPEAL

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

Pursuant to 37 C.F.R. 1.192, the Appellant hereby appeals to the Board from the Examiner's Final Office Action dated April 2, 1997. A triplicate copy of the Appeal Brief and requisite fee pursuant to 1.17(f) are attached.

I. REAL PARTY IN INTEREST

The real party in interest is Darcy Bisker.

II. RELATED APPEALS AND INTERFERENCES

There are none of which Appellant is aware.

III. STATUS OF THE CLAIMS

Claims 1-20 were initially presented. In response to an Office Action dated December 8, 1995, claims 4, 5, 6, 8, and 9 were cancelled without prejudice, claims 1-3, 7, and 10-20 were amended, and new claims 21-31 were added. In response to an Office Action dated June 28, 1996, claims 1, 26, and 28-31 were amended. Thus, claims 4, 5, 6, 8, and 9 have been cancelled, and claims 1-3, 7, and 10-31 are pending in this application and stand finally rejected by the Examiner.

IV. STATUS OF AMENDMENTS

No amendments were filed subsequent to the Final Rejection.

V. SUMMARY OF THE INVENTION

The present invention, as set forth in claims 1-3, 21 and 22, is directed to a method of creating a flooring surface including the steps of providing a photographic floor tile comprising an enlarged photographic print and a transparent barrier attached to the photographic print to prevent injury to the photographic print from foot traffic and other objects passing over the floor tile, and affixing the photographic floor tile to a floor to create a flooring surface. See specification page 3, lines 12-31, page 5, line 12 through page 6, line 10, page 6, lines 21-29.

The present invention as set forth in claims 7, 10-15, and 23-25 is directed to a photographic floor tile comprising an

enlarged photographic print and a protective barrier over the photographic print defining a barrier to prevent injury to the photographic print from foot traffic and other objects passing over the floor tile. See specification page 5, line 12 through page 6, line 10.

The present invention as set forth in claims 26-31 is directed to a floor tile for use as a flooring surface in a commercial merchandising display comprising an enlarged graphic print of photographic quality, and a transparent barrier to prevent injury to the photographic print from foot traffic passing over the floor tile. See specification, page 3, lines 4-24; page 4 lines 7-12; page 6, line 21 through page 7, line 5. Claims 28, 29, 30, and 31 are respectively directed to a floor tile creating a simulation of a retail product, a company logo, a photographed object, and a floor covering or ground terrain.

The present invention as set forth in claims 16-20 is directed to a flooring surface comprising an enlarged photographic print and a transparent barrier to prevent injury to the photographic print from foot traffic wherein the photographic print is securely affixed to the floor to create a flooring surface.

VI. ISSUES

1. Whether claims 1-3, 21 and 22 are unpatentable under 35 U.S.C. 103 in view of Travis.

2. Whether claims 7, 10-15, 23-25 are unpatentable under 35 U.S.C. 103 in view of Travis.
3. Whether claims 26-31 are unpatentable under 35 U.S.C. 103 in view of Travis.
4. Whether claims 16-20 are unpatentable under 35 U.S.C. 103 in view of Travis.

VII. GROUPING OF CLAIMS

1. **Group 1 Claims:** Claims 1-3, 21 and 22 directed to a method of creating a flooring surface stand as a single group for purposes of this appeal.
2. **Group 2 Claims:** Claims 7, 10-15, 23-25 directed to a floor tile stand as a single group for purposes of this appeal.
3. **Group 3 Claims:** Claims 26-31 are directed to a floor tile used in a commercial merchandising display. Claims 28-31 are separately patentable from claim 26 based on the particular print used in the floor tile. Claims 28-31, while separately patentable from claim 26, stand or fall together.
4. **Group 4 Claims:** Claims 16-20 directed to a flooring surface stand and fall together.

VIII. ARGUMENT

A. The rejection of claims 1-3, 7, 10-31 under 35 U.S.C. 103 in view of Travis should be withdrawn.

The Examiner finally rejected claims 1-3, 7, 10-31 under 35 U.S.C. § 103 as being obvious in view of Travis. There is no teaching, suggestion, or motivation of any kind in Travis to create a floor tile or flooring surface using an enlarged photographic print and a transparent barrier to prevent injury from foot traffic. In the June 28, 1996 Office Action upon which the Examiner stands, the Examiner noted that Travis teaches a shower or bathtub enclosure which comprises a full scale photograph or print of an image or design, and that the article is adapted for mounting upon a wall. The Examiner acknowledged that Travis does not teach the enlarged photograph as part of a flooring surface. In the Final Office Action the Examiner again acknowledged that Travis does not disclose the use of an enlarged photographic print as a floor tile.

Travis is directed to providing a waterproof print as a wall ornament on a bathtub or shower wall. The teaching of Travis involves providing a wall ornament that will withstand the moisture and water environment of a bathtub enclosure, and specifies using "a special moisture proof, water resistant ink upon a sheet 19 of synthetic paper." Col. 2, lines 8-10. The specification further states that the synthetic sheet "is non-absorbent and highly impervious against penetration by ink, water

or other fluids" and "provides a suitable substrate for imprinting thereon a graphic illustration by off-set printing, silkscreen printing or lithography." Col. 2, lines 12-16. Travis also mentions in passing that "there may be a top coating of nitrocellulose lacquer or a urethane coating applied to the imprinted sheet to provide a sheet which is scratch and scuff resistant." Col. 3, lines 1-4.

The Examiner's June 28, 1996 rejection upon which the Examiner stands is based on the proposition that "it would be obvious to one of an ordinary skill in the art to use Travis enlarged photograph of any graphic design as flooring surface because of the way it is constructed." The rejection is further based on the proposition that "the skilled person would be motivated to construct the same article from the disclosure of Travis or modify the materials for strength depending on the intended use and use the product as part of a floor tile or floor covering." The Examiner also noted that "since the product of the reference is hard and moisture and scuff resistant it would work in the same way as applicant's claimed invention."

The teaching of Travis does not render the claimed invention obvious. The claims of the present invention are directed to an enlarged photographic print as a component of a floor tile or flooring surface having a transparent barrier to prevent injury to the photographic print from foot traffic and other objects passing over said floor tile. There is no teaching or suggestion whatsoever in Travis to provide the claimed invention.

Travis provides absolutely no teaching, suggestion, or even a hint to use a photographic print in combination with a floor tile or as part of a flooring surface. The law is clear that to sustain a finding of obviousness, "there must be some teaching, suggestion, or incentive [in the prior art] to make the combination by the inventor." Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931 (Fed. Cir. 1990). Something in the prior art must suggest the desirability, and thus the obviousness, of making the combination. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051 (Fed. Cir. 1988).

While acknowledging that Travis does not teach the use of an enlarged photographic print as a floor tile, the Examiner stated in the June 28, 1996 Office Action upon which the Examiner stands that it would be obvious to use the article in Travis as a floor tile because of the way it is constructed. The construction of the waterproof wall ornament in Travis does not suggest that it be used as a floor tile. It is clear from the Travis specification that the wall ornament is specifically adapted for use in a moisture-filled environment and that the article is designed to withstand moisture penetration. There is no teaching or suggestion of any kind to use the article as part of a floor tile or flooring surface or to use the article anywhere other than as a wall ornament in a moisture-filled environment, and it therefore would not be obvious to use the article outside of a moisture-filled environment or outside of a wall ornament.

In the Final Rejection dated April 2, 1997, the Examiner stated that it is common knowledge to place an enlarged photographic print in a desired location to enhance the visual decor of a commercial setting. However, even if this were true, there it is certainly not common knowledge to use a photographic print in combination with a protective transparent barrier as a floor tile.

Moreover, Travis mentions in passing that "there may be a top coating of nitrocellulose lacquer or a urethane coating applied to the imprinted sheet to provide a sheet which is scratch and scuff resistant." In the context of Travis' disclosure, the lacquer or urethane coating would be used to prevent scuffs or scratches that may result in the bathtub enclosure. However, there is no teaching or suggestion that the lacquer or urethane coating could be used as part of a floor tile to form a barrier that prevents injury to the photographic print from foot traffic or other objects passing over the floor, nor is it apparent that the article in Travis could even be used as a floor tile. Simply because a wall-mounted waterproof graphic print has a coating to prevent scratches and scuffs in a bathtub does not render obvious the combination of a floor tile or flooring surface with an enlarged photographic print having a barrier sufficient to prevent injury from foot traffic. Even if Travis could be used as part of a floor tile, to sustain an obvious rejection, there must be a teaching or suggestion in Travis to use the graphic print as a floor tile. As Federal Circuit authority establishes:

Obviousness is tested by what the combined teachings of the references would have suggested to those of ordinary skill in the art. But it cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. And teachings of references can be combined only if there is some suggestion or incentive to do so.

In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

The Examiner acknowledges that there is no teaching in Travis to use the enlarged print as a floor tile, and there is also no suggestion to use the print in Travis as a floor tile. The Examiner has pointed to no suggestion in Travis to use the enlarged print in combination with a floor tile or flooring surface.

The June 28, 1996 rejection upon which the Examiner stands is also based on the proposition that "the skilled person would be motivated to construct the same article from the disclosure of Travis or modify the materials for strength depending on the intended use and use the product as part of a floor tile or floor covering." Similarly, in the Final Rejection the Examiner again stated the it would be obvious to provide a protective coating of a certain type depending on the use. However, the point is that the use of a photographic print as a floor tile would not be obvious, and therefore providing a transparent barrier to prevent injury from foot traffic would also not be obvious. There is simply no teaching, suggestion, or motivation anywhere in Travis to combine a transparent barrier with a enlarged photographic print to create a floor tile or flooring surface. Applicant respectfully submits, that this ground of rejection is based on

improper hindsight reconstruction. Again the law is clear, the obviousness determination must be made at the time the invention was made and the applicant's disclosure may not be used as a guide to combine the prior art to come up with the claimed invention.

In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988) (it is essential that the Examiner forget what he has been taught about the claimed invention by the inventor). It should also be noted that it is irrelevant that all elements of an invention may have been old, as virtually all inventions are combinations of old elements.

Environmental Designs, Ltd. v. Union Oil Co. of California, 713 F.2d 693, 698 (Fed. Cir. 1983).

Essentially, the Examiner has assumed the existence of the claimed combination and stated that it would be obvious to use the article of Travis as part of the claimed combination. However, this rationale fails to recognize that to support an obviousness rejection, Travis must itself suggest the combination. There is no teaching or suggestion in Travis of the combination of a transparent barrier sufficient to prevent injury from foot traffic with an enlarged photographic print to create a floor tile or flooring surface.

With respect to improper hindsight reasoning, in the Final Rejection, the Examiner has taken the position that any judgment of obviousness requires in a sense a reconstruction based upon hindsight reasoning. The Examiner further has taken the position that hindsight reconstruction is proper as long as it takes into account only knowledge within the level of ordinary skill at the

time the invention was made, and does not include knowledge gleaned from the applicant's disclosure. The Examiner's reasoning is faulty for two reasons. First, hindsight reasoning is improper. The law is clear that the prior art either alone or in combination must suggest the claimed combination. Here, as discussed above, Travis clearly does not suggest the claimed combination. Second, even taking into account the knowledge of one skilled in the art, there is no evidence that one skilled in the art would know to combine a transparent barrier with an enlarged photographic print to create a floor tile or a flooring surface. In fact, such knowledge is not within the level of one of ordinary skill in the art.

Furthermore, in the June 28, 1996 rejection upon which the Examiner stands, the Examiner's suggestion that Travis could be modified to produce the claimed invention is insufficient to sustain an obviousness rejection unless Travis suggested the desirability of the modification, which it does not. In re Laskowski, 871 F.2d 115, 117 (Fed. Cir. 1989) ("the mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification"), quoting, In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984). Since the Examiner has not provided the necessary suggestion or motivation to modify Travis to produce the claimed invention, the rejection under 103 should be withdrawn.

1. The rejection of Claims 1-3, 21, and 22 directed to a method of creating a flooring surface under 35 U.S.C. 103 in view of Travis should be withdrawn

Claims 1-3, 21, and 22 are directed to a method of creating a flooring surface using an enlarged photographic print and a transparent barrier to prevent injury to the print from foot traffic. As discussed above, the claimed method of creating a flooring surface is not rendered obvious by the teaching of Travis to provide a waterproof print affixed to the wall of a bathtub or shower enclosure. There is no teaching or suggestion in Travis of the claimed method. The rejection under 103 of claims 1-3, 21, and 22 directed to a method of creating a flooring surface should be withdrawn.

2. The rejection of claims 7, 10-15, and 23-25 directed to a floor tile comprised of an enlarged photographic print and a transparent barrier sufficient to prevent injury to the print from foot traffic over the floor tile under 35 U.S.C. 103 in view of Travis should be withdrawn

Claims 7, 10-15, and 23-25 are directed to a floor tile comprised of an enlarged photographic print and a transparent barrier sufficient to prevent injury to the print from foot traffic passing over the floor tile. The claimed invention is not rendered obvious in view of the waterproof wall ornament with a lacquer coating used in a bathtub or shower enclosure disclosed in Travis. As discussed above, there is no teaching or suggestion in Travis either alone or in combination with the knowledge of one

skilled in the art to provide the claimed floor tile. The rejection of claims 7, 10-15, and 23-25 under 103 over Travis should be withdrawn.

3. The rejection of claims 26-31 directed to a floor tile comprised of an enlarged photographic print and a transparent barrier sufficient to prevent injury to the print from foot traffic over the floor tile under 35 U.S.C. 103 in view of Travis should be withdrawn

Claims 26-31 are directed to a floor tile in a commercial merchandising display comprised of an enlarged print and a transparent barrier sufficient to prevent injury to the print from foot traffic over the floor tile. The claimed invention is not rendered obvious in view of the waterproof wall ornament with a lacquer coating used in a bathtub or shower enclosure disclosed in Travis. As discussed above, there is no teaching or suggestion in Travis either alone or in combination with the knowledge of one skilled in the art to provide the claimed floor tile. Moreover, there is no teaching or suggestion in Travis to use the floor tile of the claimed invention in a commercial merchandising display. Travis teaches the use of a wall ornament in a private bathtub or shower enclosure. The rejection of claims 26-31 under 103 over Travis should be withdrawn.

Moreover, claims 28-31 are specifically directed to a print depicting a retail product, company logo, photographed object, and a floor covering or ground terrain in claims 28-31 respectively. These claims are separately patentable from claim 26 from which

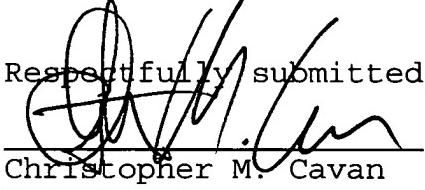
they depend. In particular, claims 28 and 30 respectively provide a simulation of a retail product or photographed object, and claim 31 provides a simulation of a floor covering or ground terrain. Travis does not teach or suggest the provision of such simulations. Accordingly, the rejection of claims 28-31 under 35 U.S.C. 103 should be withdrawn.

4. The rejection of claims 16-20 directed to a flooring surface comprised of an enlarged photographic print and a transparent barrier sufficient to prevent injury to the print from foot traffic over the floor tile under 35 U.S.C. 103 in view of Travis should be withdrawn

Claims 16-20 are directed to a flooring surface comprised of an enlarged photographic print and a transparent barrier sufficient to prevent injury to the print from foot traffic over the floor tile. The claimed invention is not rendered obvious in view of the waterproof wall ornament with a lacquer coating used in a bathtub or shower enclosure disclosed in Travis. As discussed above, there is no teaching or suggestion in Travis either alone or in combination with the knowledge of one skilled in the art to provide the claimed floor tile. Moreover, there is no teaching or suggestion in Travis to use a photographic floor tile in a commercial merchandising display. The rejection of claims 16-20 under 103 over Travis should be withdrawn.

IX. CONCLUSION

For all of the above reasons, the Appellant requests that the Board withdraw the Examiner's rejections and hold that the claims 1-3, 7, 10-31 are allowable in their present form.

Respectfully submitted,

Christopher M. Cavan
Reg. No. 36,475
Attorney for Applicant

MCDONNELL BOEHNEN
HULBERT & BERGHOFF
300 S. Wacker, Suite 3200
Chicago, IL 60606

APPENDIX

Claim 1. A method of creating a flooring surface comprising the steps of:

providing a floor tile comprising an enlarged photographic print and a transparent protective coating attached to said photographic print, said protective coating defining a barrier to prevent injury to said photographic print from foot traffic and other objects passing over said floor tile;

affixing said floor tile to a floor to create said flooring surface.

Claim 2: The method of claim 1, wherein said enlarged photographic print comprises a photograph of an object, and said photographic print has been enlarged sufficiently to create a substantially full scale, full size simulation of said object.

Claim 3: The method of claim 1, wherein said enlarged photographic print comprises a photograph of an object, and said photograph has been enlarged sufficiently to create a substantially larger than full scale, full size simulation of said object.

Claim 7: A floor tile for use as a flooring surface comprising:
an enlarged photographic print having oppositely
disposed first and second major faces; and
a transparent protective coating on said first major
face, said protective coating defining a barrier to prevent injury
to said photographic print from foot traffic and other objects
passing over said floor tile.

Claim 10: The floor tile of claim 7, wherein said transparent
protective coating comprises vinyl.

Claim 11: The floor tile of claim 10, wherein said protective
coating has a thickness of about 5 millimeters.

Claim 12: The floor tile of claim 7 further comprising:
an adhesive disposed on at least a portion of said
second major face and adapted to secure said second major face to
a floor; and
a backing liner covering said adhesive and removable
therefrom to permit said adhesive to be affixed to said floor.

Claim 13: The floor tile of claim 7, wherein said photographic
print is a photograph of an object, and said photographic print
has been enlarged sufficiently to create a substantially full
size, full scale, simulation of said object.

Claim 14: The floor tile of claim 12, wherein said photographic print is a photograph of an object, and said photographic print has been enlarged sufficiently to create a substantially full size, full scale simulation of said object.

Claim 15: The floor tile of claim 7, wherein said photographic print is a photograph of an object, and said photographic print has been enlarged sufficiently to create a substantially larger than full size, full scale simulation of said object.

Claim 16: A flooring surface comprising:

an enlarged photographic print having oppositely disposed first and second major faces;

a transparent protective coating on said first major face defining a barrier to prevent injury to said photographic print from foot traffic and other objects passing over said photographic print; and

wherein one or more of said photographic prints is securely affixed to a floor to create said flooring surface.

Claim 17: The flooring surface of claim 16, wherein said photographic print is a photograph of an object, and said photographic print has been enlarged sufficiently to create a substantially full size, full scale simulation of said object.

Claim 18: The flooring surface of claim 16, wherein said photographic print is a photograph of an object, and said photographic print has been enlarged sufficiently to create a substantially larger than full size, full scale simulation of said object.

Claim 19: The flooring surface of claim 16, wherein said flooring surface comprises a plurality of said photographic prints affixed to said floor in combination to create a visually appealing pattern.

Claim 20: The flooring surface of claim 16, wherein said flooring surface comprises a plurality of said photographic prints affixed to said floor in combination to create a simulation of an object.

Claim 21: The method of claim 1 wherein said photographic print comprises plastic print material to provide for enhanced durability of the floor tile.

Claim 22: The method of claim 1 wherein said photographic print comprises polyester-based print material with a thickness of about 9 millimeters.

Claim 23: The floor tile of claim 7 wherein said photographic print comprises plastic print material to provide for enhanced durability of the floor tile.

Claim 24: The floor tile of claim 7 wherein said photographic print comprises polyester-based print material with a thickness of about 9 millimeters.

Claim 25: The floor tile of claim 7 where one or more of said floor tiles are affixed to a floor to define said flooring surface.

Claim 26: A floor tile for use as a flooring surface in a commercial merchandising display comprising:

an enlarged graphic print of photographic quality having oppositely disposed first and second major faces; and

a transparent protective coating on said first major face defining a barrier to prevent injury to said photographic print from foot traffic and other objects passing over said floor tile.

Claim 27: The floor tile of claim 26 further comprising:

an adhesive disposed on at least a portion of said second major face and adapted to secure said second major face to a floor;

and a backing liner covering said adhesive and removable therefrom to permit said adhesive to be affixed to said floor.

Claim 28: The floor tile of claim 26, wherein said print depicts a retail product, and said print has been enlarged sufficiently to create a substantially full size, full scale simulation of said retail product.

Claim 29: The floor tile of claim 26, wherein said print has been enlarged sufficiently to create a large scale reproduction of a company logo as part of said merchandising display.

Claim 30: The floor tile of claim 26 wherein one or more of said floor tiles are affixed to a floor in combination to create a photographic simulation of an object.

Claim 31: The floor tile of claim 26 wherein said print has been enlarged sufficiently to create a substantially full size, full scale photographic simulation of an actual floor covering or ground terrain.